

USSN: 10/057,852

Atty. Docket No.: 2002B012

Amdt. dated August 25, 2003

Reply to Office Action of April 23, 2003

REMARKS/ARGUMENTS

In the Office Action dated April 23, 2003, the Examiner rejected Claims 1-7 and 11-18 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 6,461,706 (Freedman) in view of U.S. Patent 6,210,524 (Josephy). The Examiner rejected Claims 1-20 under 35 U.S.C. §112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Finally, the Examiner indicated that Claims 8-10 and 18-20 are free of the prior art.

Initially, Applicant notes with appreciation the Examiner's indication that Claims 8-10 and 18-20 are free of the prior art. In response to the Office Action, Applicant has traversed the §103(a) and §112, first paragraph, rejections of the claims. A Rule 132 Declaration in support of Applicant's arguments is being filed simultaneously herewith.

The Examiner rejected Claims 1-7 and 11-18 under 35 U.S.C. §103(a) as being unpatentable over Freedman in view of Josephy. In this regard, the Examiner states that:

Freedman relates to a co-extruded face stock for labels (abstract) comprising as shown in Figures 1-3, a core layer with two skin layers adhered to it (col. 10, lines 40-50). The core layer includes a blend of about 5% to 95% by weight of propylene homopolymer and 95% to 5% by weight of at least one propylene copolymer such as with an ethylenic content of 2 to 10% by weight (col. 3, lines 50-55, and col. 4, lines 20-24 and 34-40). The skin layer may contain anti-block agent in an amount of 500 to 5000 ppm (col. 6, lines 59-62). The thickness of the core layer and the skin layers are 1 to mils (core), and the skin layers being less than 0.5 mils (col. 9, lines 11-12 and col. 10, lines 30-36). Also disclosed in Freedman is a label stock comprising a face stock, a pressure sensitive adhesive layer covered with a release liner. However, Freedman fails to teach that the co-extruded face stock is biaxially oriented. Josephy discloses a label face stock (abstract) wherein the face stock can be uniaxially or biaxially oriented to improve the properties of the face stock (col. 7, lines 5-13). Therefore, it would have been obvious to one having ordinary skill in the art to utilize Josephy's teaching of providing biaxial orientation to the face stock in the invention of Freedman.

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As for the transverse direction orientation degree being 7 to 10 and the machine direction degree of orientation being 3.5 to 6, it would have been obvious optimization through routine experimentation for stiffness, dispensability, die-cutability, etc., properties.

Applicant respectfully traverses the foregoing rejection of the claims. The Freedman reference cited by the Examiner is directed to a multilayer film facestock for labels. Particularly, Freedman is concerned with preparing a facestock "which is thinner than the 'standard' 4 mils, printable, die-cuttable and dispensable." (column 2, lines 47-50). Freedman teaches at column 8, lines 51-56 that "the desirable properties of the multilayer film facestocks of the present invention are improved...when at least the base layer, and more preferably, the entire facestock, has been oriented in the machine direction **only**." In this regard, Freedman teaches that biaxially-oriented films exhibit unacceptable conformability characteristics. More specifically, Freedman teaches that when biaxially-oriented films are applied to rigid substrates such as glass bottles, the application is not completely successful. (column 2, lines 5-7). Freedman further teaches that the "relatively stiff labels have a tendency to bridge surface depressions and the mold seems resulting from bottle-forming processes resulting in an undesirable surface appearance of the applied label simulating trapped air bubbles" (column 2, lines 5-11).

The Examiner also relies upon the Josephy reference in support of his §103(a) rejection of the claims. In this regard, Josephy is directed to a method of improving peel-plate dispensability of label constructions. Particularly, Josephy is concerned with temporarily increasing the stiffness of a label by cooling such label prior to dispensing. The patent states at column 3, lines 43-47 that the "method of the invention relates to a method of improving the peel-plate dispensability of a die-cut and matrix-stripped label construction which normally does not have the required machine direction (MD) stiffness to be successfully dispensed over a peel-plate at room temperature." Thus, the film structures of Josephy are distinct from both the films of the present invention and from the films disclosed in Freedman because the Josephy films lack the stiffness required for dispensability, even if such structures have been oriented as disclosed at column 7, lines 6-15.

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The Examiner argues that Freedman discloses the claimed invention with the exception of biaxial orientation. He then argues that Josephy discloses a label facestock wherein the facestock can be uniaxially or biaxially oriented, and that it would have been obvious to one having ordinary skill in the art to utilize the teachings of Josephy to biaxially orient the facestock of Freedman. Applicant respectfully disagrees. As discussed in the present specification and as illustrated by the examples, particularly the Comparative Examples, the design of a facestock suitable for conformable pressure-sensitive labels depends on a plurality of factors including formulation, construction, thickness and orientation. Although one might have anticipated that any number of combinations would produce facestock having these required properties, it has been discovered herein that only a select set of properties provides a facestock which simultaneously exhibits the squeezability, dispensability and die-cutability characteristics necessary for automated conformable label applications. Comparative Examples 1-5 show that other designs failed to simultaneously provide all of these desired characteristics.

It is respectfully submitted that the Examiner has failed to set forth a *prima facie* case of obviousness with respect to the pending claims. It is well settled that an Examiner must "show a motivation to combine the references that create the case of obviousness." In re Rouffet, 149 F.3d 1350, 1357 (Fed. Cir. 1998). Here, the Examiner has failed to do so. The Examiner's argument that it would have been obvious to one having ordinary skill in the art to utilize the teachings of Josephy to biaxially orient the facestock of Freedman completely avoids the issue of motivation.

The Examiner argues that Freedman discloses all the limitations of the claimed invention, with the exception of biaxial orientation. However, such an argument suggests that Freedman merely fails to disclose biaxial orientation, when in fact Freedman specifically teaches away from biaxial orientation. Particularly, Freedman teaches the use of machine direction **only** orientation because, as Freedman notes, biaxial orientation has produced unacceptable conformability characteristics in prior art film structures. Notwithstanding this direct teaching to the contrary, the Examiner argues that the teachings of Freedman simply mean that biaxial

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orientation is "not desired", not that it cannot be formed. Of course, such an argument highlights the fact that Freedman fails to provide the motivation required by the law.

Contrary to the Examiner's argument, Josephy also fails to provide the required motivation. As mentioned, the film structures disclosed in Josephy are distinct from the film structures of the present invention, as well as the film structures disclosed in Freedman, in that such film structures are stated to lack the required machine direction and stiffness to be successfully dispensed over a peel-plate at room temperature, even if such structures have been uniaxially or biaxially oriented. Josephy is therefore directed to a unique problem involving unique film structures. There is simply no teaching found in Josephy which would provide the motivation required to support the Examiner's combination of references. In re Rouffet, 149 F.3d 1350 (Fed. Cir. 1998).

The stated purpose of the Freedman patent is to provide a multilayer film facestock useful in preparing printed labels "at a thinner gauge which exhibits desirable features of the 'standard' polyethelene facestocks such as printability, stiffness, flexibility, die-cuttability, and dispensability." Thus, because flexibility is one of the stated goals, there would be absolutely no motivation (even in light of Josephy) for one skilled in art to biaxially orient the film structure of Freedman in view of the specific teaching that such film structures should be oriented in the machine direction **only** because biaxial orientation has produced unacceptable conformability characteristics in prior art film structures. In re Gordon, 733 F.2d 900, 992 (Fed. Cir. 1984) (modification which renders reference inoperable for its intended purpose is improper); In re Fritch, 972 F.2d 1260, 1265-66 n. 12 (Fed. Cir. 1992).

In view of the foregoing, it is respectfully submitted that the Examiner has failed to set forth a *prima facie* case of obviousness with respect to the pending claims. The §103(a) rejection of Claims 1-7 and 11-18 is therefore improper, and should be withdrawn. Notwithstanding the foregoing, Applicant has amended independent Claims 1 and 11 to more particularly recite that the facestock simultaneously exhibits the squeezability, dispensability and die-cuttability characteristics necessary for automated conformable label applications.

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The Examiner rejected Claims 1-20 under 35 U.S.C. §112, first paragraph, as containing subject matter that is not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In this regard, the Examiner states that:

The specification fails to teach the basis for the percentage of composition of the core layer. In the absence of such basis, it not deemed to be enabling.

Applicant respectfully traverses the foregoing rejection of the claims. As stated in the attached Rule 132 Declaration, it is the standard of this industry, and is certainly the standard of ExxonMobil, the assignee of the above-referenced invention, to use percentages by weight when describing polymeric film structures. In fact, the two references cited by the Examiner describe polymeric compositions by weight, as do the plurality of patents cited in the Information Disclosure Statement filed on March 22, 2002. Thus, a person skilled in the art, unless specifically advised to the contrary, would understand that the polymeric compositions identified in the above-referenced specification, are by weight.

It is therefore respectfully submitted that the specification, as currently written, provides enablement for the claimed invention. Accordingly, the §112, first paragraph rejection of the claims should be withdrawn.

Applicant respectfully notes that the Information Disclosure Statement filed on March 22, 2002 has apparently not been matched with the present file. Copies of the filed Information Disclosure papers, together with the postcard sent with the IDS on March 22, 2002, are attached as Exhibit A. Applicant has not yet received a stamped, return postcard. It is respectfully requested that the Examiner consider the enclosed IDS, and acknowledges consideration of such references on the accompanying form PTO-1449.

In view of the amendments to the claims, together with the remarks set forth above, it is respectfully submitted that the present application is in all respects, complete and in condition for allowance. Accordingly, reconsideration and allowance of the pending claims is respectfully solicited.

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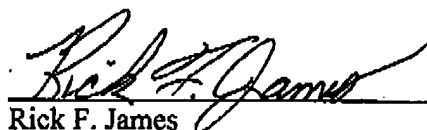
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In the event that the Examiner has any questions concerning this Amendment, he is invited to contact the undersigned attorney.

Respectfully submitted,

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